REMARKS

By this amendment, Applicants amend the specification and claims 16 and 34 to correct minor informalities.

In the Office Action dated September 9, 2004, the Examiner: (1) rejected claims 1-15 and 35 under 35 U.S.C. § 112, second paragraph, as being indefinite; (2) rejected claims 1-14, 16-31 and 33-35 under 35 U.S.C. § 102(e) as being anticipated by Touboul (U.S. Patent No. 6,092,194); and rejected claims 15 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Touboul in view of Donaldson (U.S. Patent 6,231,267).

Based on the following remarks, Applicants traverse each of the above rejections. Each rejection set forth in the outstanding Office Action is addressed under a parallel heading below.

Claim Rejections – 35 U.S.C. § 112

Claims 1-15 and 35 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner asserts that "it is unclear whether the means [for] determining a home site name for the applet ... is done on the client or server side of the network."

Initially, Applicants note that claim 1 does not recite a "means for determining a home site name for the applet." Rather, claim 1 recites "[a] method of creating a network connection between an applet executing on a client computer and a content server computer, the method comprising: [*inter alia*] determining a home site name for the applet ...." Further, while claim 35 does recite "means for determining a home site

name for the applet ...," Applicants submit that such recitation does not render claim 35 indefinite.

Applicants do not regard their invention as limited with respect to where the function "determining a home site name for the applet" is performed. In making this rejection, the Examiner does not allege that a person of ordinary skill in the art could not interpret the metes and bounds of claims 1-15 and 35 so as to understand how to avoid infringement. *See* M.P.E.P. § 2173.02 (8th Ed., Rev. 2, May 2004). Instead, it appears that the Examiner has confused claim breadth with indefiniteness. This is improper:

> Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

M.P.E.P. § 2173.04 (8th Ed., Rev. 2, May 2004). Thus, 35 U.S.C. § 112, second paragraph, does not require Applicants to narrow their claims when the claims as a whole particularly point out and distinctly claim what Applicants regard as their invention.

When properly analyzed in light of the claim language, the content of the specification, and the teachings of the prior art, the claimed "means for determining a home site name for the applet" clearly defines the subject matter that Applicants consider within the scope of their invention with reasonable particularity and precision. Consequently, Applicants respectfully request that the rejection of claims 1-15 and 35 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Claim Rejections – 35 U.S.C. § 102

Claims 1-14, 16-31 and 33-35 are rejected under 35 U.S.C. 102(e) as allegedly anticipated by Touboul. Applicants respectfully traverse these rejections because Touboul does not teach each and every recitation of claims 1-14, 16-31 and 33-35.

Touboul

Touboul discloses a system and method for protecting a client computer from suspicious "Downloadables," i.e., executable application programs, such as applets. *See* col. 1, ll. 44-57. The Touboul method is invoked when a Downloadable is *received* from an external network, i.e., downloaded. *See* col. 1, ll. 44-47; col. 3, ll. 10-12; col. 7, ll. 48-49; col. 10, ll. 9-10; and FIG. 6, step 602.

Once received, the Downloadable is examined to determine whether it violates a preset security policy. *See* col. 2, ll. 25-26; and col. 10, 11-16. To make this determination, Touboul:

> examine[s] the URL identifying the source of the Downloadable against URLs stored in [a] URL rule base 420 to determine whether the Downloadable comes from a trusted source. ...[T]he Downloadable [may be deemed] suspicious if the Downloadable comes from an untrustworthy source or if the Downloadable did not come from a trusted source.

Col. 6, ll. 38-45.

If the Downloadable is deemed "suspicious," the Downloadable is "discard[ed]." Col. 2, ll. 26-28. In other words, if the Downloadable violates the security policy, the system "*prevents* [the suspicious Downloadable] *from reaching* the internal computer network." Col. 3, ll. 10-13 (emphasis added). Touboul thus "*prevent[s] execution* of the

Downloadable by the client if the security policy has been violated." Col. 10, ll. 17-18 (emphasis added).

Consequently, during the performance of the Touboul method, the Downloadable is not executing: it is simply data that is being downloaded. The Downloadable is not allowed to execute until after the system has established that the Downloadable does not violate the security policy. *See* col. 3, ll. 10-13; col. 10, ll. 17-18.

Independent Claims 1, 16 and 33-35

The Examiner asserts that Touboul discloses each and every recitation of claims 1-14, 16-31 and 33-35. However, independent claim 1 sets forth "[a] method of creating a *network connection* between an applet executing on a client computer and a content server computer," the method comprising, *inter alia*, "permitting *the applet* to create a *network connection* with the content server computer if the hostname entry was present." Claim 1, ll. 1-2 and 9-10 (emphasis added). Claim 34 sets forth a method containing similar recitations; claim 33 sets forth a computer data signal including program code for performing similar recitations. *See* claim 33, ll. 10-11; claim 34, ll. 1-2 and 6-7.

Because the applet (i.e., the Downloadable) is not executing during performance of the Touboul method, Touboul does not discuss "permitting *the applet* to create a *network connection*," as recited in claims 1, 33 and 34. Although Touboul may "allow" the Downloadable if it "comes from a trusted source" and does not otherwise violate the security policy (*see* col. 6, ll. 38-48), this merely allows *the client* to download the applet. *See* col. 3, ll. 10-13; col. 10, ll. 17-18. Permitting the client to download the applet does

not equate to "permitting the applet to create a network connection with the content server," as recited in claims 1, 33 and 34. Instead, it merely allows the applet to reside on the client system.

Similarly, claim 1 further recites "denying permission for the applet to create a network connection with the content server computer if the hostname entry was not present." Claim 1, ll. 11-12. Claims 16, 33 and 35 contain similar recitations. *See* claim 16, ll. 13-15; claim 33, ll. 12-14; claim 35, ll. 9-11. Although Touboul "blocks" a Downloadable if it "comes from an untrustworthy source," (*see* col. 6, ll. 38-48), Touboul does not discuss "deny[ing] permission for *the applet* to create a *network connection* with the content server computer," as recited in claims 1, 16, 33 and 35 (emphasis added). It merely denies the client permission to download the applet.

For at least these reasons, Applicants submit that Touboul fails to show or even suggest each and every recitation of independent claims 1, 16 and 33-35. Accordingly, Applicants respectfully request that the rejection of these claims under 35 U.S.C. § 102(e) be withdrawn and the claims allowed.

Dependent Claims 2-14 and 17-31

Claims 2-14 depend from claim 1 and claims 17-31 depend from claim 16. As explained above, claims 1 and 16 are distinguished from Touboul. Consequently, claims 2-14 and 17-31 are likewise distinguished from Touboul for at least the same reasons given above for claims 1 and 16. Further, Touboul fails to teach each and every recitation added in claims 2-14 and 17-31.

For example, claims 2 and 17 recite, "generating a Uniform Resource Locator for the hostname entry on the content server computer." The Examiner alleges that such recitations are taught by Touboul. *See* Office Action, p. 4, ll. 4-5 (citing Touboul, col. 4, ll. 41-61). However, contrary to the Examiner's assertions, Touboul does not disclose that the Downloadable ID, itself, includes the URL from which the Downloadable came. Instead, the Downloadable ID "includes a digital hash of the complete Downloadable code." Col. 4, ll. 45-47. Moreover, Touboul nowhere discloses "sending an HTTP request using the Uniform Resource Locator to the content server computer to determine whether the hostname entry is present in the name directory on the content server computer," as recited in claims 2 and 17.

The Examiner also cites Touboul, col. 4, ll. 41-61, as teaching the subject matter of claims 3 and 19. *See* Office Action, p. 4, ll. 10-13. However, although the ID generator 315 of Touboul "receives a Downloadable[,] the URL from which it came and the intended recipient," (col. 4, ll. 41-43), this does not teach a "Uniform Resource Locator ... combining a host name of the content server computer, a path name of the name directory, and a name of the hostname entry," as recited in claims 3 and 19. For example, neither of the components cited by the Examiner include "a host name of the content server."

Further, claims 14 and 31 recite "denying permission for the applet to create a network connection with the content server computer if the address list for the content server computer is not a subset of the address list for the computer from which the applet was downloaded." Contrary to the Examiner's assertions, Touboul fails to

discuss such subsets, either in the cited portions thereof (col. 4, ll. 41-61; col. 6, ll. 41-51; col. 7, ll. 60-67; and col. 8, ll. 1-10), or anywhere else.

For at least these reasons, Touboul fails to teach each and every recitation of claims 2-14 and 17-31. Accordingly, Applicants respectively request that the rejection of claims 2-14 and 17-31 under 35 U.S.C. § 102(e) be withdrawn and these claims allowed along with claims 1 and 16.

Claim Rejections – 35 U.S.C. § 103

Claims 15 and 32 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Touboul in view of Donaldson. However, claims 15 and 32 depend from one of claims 13 and 30, respectively. As explained above, claims 13 and 30 are distinguished from Touboul. Moreover, Donaldson is not relied upon to teach, and, in fact, does not teach the above-cited deficiencies of Touboul. Therefore, claims 15 and 32 are distinguished from Touboul and Donaldson for at least the reasons set forth above with respect to claims 13 and 30. Accordingly, Applicants respectfully request that the rejection of claims 15 and 32 be withdrawn and the claims allowed.

Conclusions

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 7, 2004

By: _____
John M. Mulcahy
Reg. No. 55,940